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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,001

12/16/2005

Valerie Andre

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EXAMINER

KARPINSKI, LUKE E

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

10/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,001	Applicant(s) ANDRE ET AL.	
	Examiner LUKE E. KARPINSKI	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-10,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-10,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Change in Examiner

The examination of this action will now be handled by Luke Karpinski, contact information can be found at the end of this action.

Receipt of Amendment and Arguments/Remarks filed 7/01/2008 is acknowledged.

Claims

Claims 2-6 and 11-18 have been canceled.

Claims 1, 7-10, 19, and 20 are currently pending and under consideration in this action.

Previous Rejections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

New Rejections

Claim Rejections - 35 USC § 103

Art Unit: 1616

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1, 7-10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,387,355 to Heidenfelder et al.

Applicant Claims

Applicant claims a liquid mixture consisting of a UV-A filter (diethylamino hydroxybenzoyl hexyl benzoate) and a UV-B filter (2-ethylhexyl 4-methoxycinnamate), wherein said UV-A filter is present at 30-50% and said UV-B filter is present at 70-50% and said UV-A filter does not crystallize out.

Applicant further claims additional percentages for said filters and viscosities for said composition. Applicant further claims a process for preparing a cosmetic and pharmaceutical composition comprising mixing the composition of claim 1 with at least one oil phase.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Heidenfelder et al. teach sunscreen combinations as a constituent of cosmetic and pharmaceutical preparations (abstract), said constituent comprising compounds absorbing UV-A radiation, specifically with R^1 - R^3 equal to a C_1 - C_{20} alkyl (col. 2, lines 21-49 and claims 1-14), and compounds which absorb UV-B radiation, specifically 2-ethylhexyl 4-methoxycinnamate (col. 2 lines 21-28 and col. 14, line 54) as pertaining to claim 1. Heidenfelder et al. also teach said UV-A filter present at 5-50% of the combination of a UV-A filter and a UV-B filter, which would mean that said UV-B filter would be present from 50-95% (col. 5, lines 41-47), which reads on the percentage limitations of claims 1 and 7

Heidenfelder et al. further teach the addition of said constituent to a carrier containing at least one oil phase to prepare a cosmetic or pharmaceutical preparation

Art Unit: 1616

(col. 8, line 63 to col. 9, line 44 and col. 12, lines 37-44) as pertaining to claims 19 and 20.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

Heidenfelder et al. do not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, Heidenfelder et al. do teach that said components may be formulated in the same composition at the claimed percentages.

Heidenfelder et al. also do not teach the viscosities recited in claims 8-10.

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because Heidenfelder et al. suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Although Heidenfelder et al. do not explicitly disclose a compositions consisting of diethylamino hydroxybenzoyl hexyl benzoate and 2-ethylhexyl 4-methoxycinnamate the references does disclose a UV-A filter and a UV-B absorber and optional additional

Art Unit: 1616

sunscreens. The general formula given in col. 2, lines 30-40 reads on diethylamino hydroxybenzoyl hexyl benzoate and 2-ethylhexyl 4-methoxycinnamate is a UV-B absorber, which is specifically named. Although other sunscreens may be added it would have been obvious to omit said additional sunscreens as the compositions would still be functional without the addition of more sunscreen agents.

Regarding the limitations of viscosities; Heidenfelder et al. teach compositions which are materially the same as those claimed and a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, the compositions of Heidenfelder et al. would also be fluid compositions and the UV-A filter would not crystallize out for the same reasons as above.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claims 1, 7-10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,409,995 to Haybeck et al.

Applicant Claims

Applicant claims a liquid mixture consisting of a UV-A filter (diethylamino hydroxybenzoyl hexyl benzoate) and a UV-B filter (2-ethylhexyl 4-methoxycinnamate), wherein said UV-A filter is present at 30-50% and said UV-B filter is present at 70-50% and said UV-A filter does not crystallize out.

Applicant further claims additional percentages for said filters and viscosities for said composition. Applicant further claims a process for preparing a cosmetic and pharmaceutical composition comprising mixing the composition of claim 1 with at least one oil phase.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Haybeck et al. teach amino-substituted hydroxybenzophenones (col. 2, lines 17-67), specifically diethylamino hydroxybenzoyl hexyl benzoate (col. 17, table 2, no. 5) and 2-ethylhexyl 4-methoxycinnamate (col. 13, line 55 to col. 14, line 16) together as a component in cosmetic and pharmaceutical compositions (col. 11, lines 42-51), said UV-A filter present at 10-90% and 20-50% and said UV-B absorber present at 10-90 and 50-80% (col. 13, lines 47-54), said UV-A filter as a lesser amount than said UV-B filter (col. 11, lines 42-51), and said compositions in liquid form (col. 13, line 38) as claimed in claim 1.

Haybeck et al. further teach said sunscreen mixtures as present in cosmetic and pharmaceutical formulations further comprising an oil phase (col. 11, lines 42-55) as claimed in claims 19 and 20.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

Haybeck et al. do not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, Haybeck et al. do teach that said components may be formulated in the same composition at the claimed percentages.

Haybeck et al. also do not teach the viscosities recited in claims 8-10.

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because Haybeck et al. suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Although Haybeck et al. do not explicitly disclose a compositions consisting of diethylamino hydroxybenzoyl hexyl benzoate and 2-ethylhexyl 4-methoxycinnamate the reference does disclose a UV-A filter and a UV-B filter and Diethylamino hydroxybenzoyl hexyl benzoate and 2-ethylhexyl 4-methoxycinnamate are both specifically named.

Regarding the limitations of viscosities; Haybeck et al. teach compositions which are materially the same as those claimed and a chemical composition and its properties

Art Unit: 1616

are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, the compositions of Haybeck et al. would also be fluid compositions and the UV-A filter would not crystallize out for the same reasons as above.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments with respect to claims 1 and 7-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Claims 1, 7-10, 19, and 20 are rejected.

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/
Primary Examiner, Art Unit 1616

Application/Control Number: 10/561,001
Art Unit: 1616

Page 11